

The Office Action dated January, 1997 has been carefully reviewed. In response thereto, claims 10 - 12 have been amended. No new matter has been added by claim amendments.

### **B. Overview of 1987 specification**

In their 1987 continuation-in-part specification, applicants disclose "an integrated system of programming communication" which encompasses many inventions and deliberately includes many embodiments. Their teaching technique is to introduce the principles of their integrated system in a series of *related* examples. Each example builds upon structure and principles introduced earlier. Examining basic principles in detail in early examples, enables the specification with concreteness to expand and extend the scope of the teaching in later examples.

Starting with "**One Combined Medium**" on page 19 which focuses on the creation and delivery of a receiver specific graph in a broadcast or cablecast television program, "Wall Street Week," the specification introduces concepts of personalization of mass media and broadcast control of receiver station computing equipment. At page 28 *et seq.* it describes apparatus that include signal processors and signal decoders and introduces the concept of a signal processor *system*. At page 40 *et seq.* it teaches the composition of signal information and the organization of message streams.

Then in a series of four **examples, #1 through #4** which begin on pages 108, 143, 162, and 197 respectively, the specification demonstrates how receiver stations communicate signal processor apparatus and methods ("SPAM") processor code and data of the integrated system of programming communication to *some* apparatus they actuate, how decryption occurs, how metering and monitoring take place, and how actuated apparatus perform. Each example builds on concepts introduced earlier in the specification to provide a detailed teaching of its own subject matter, and a particularly important teaching occurs from pages 156 through 162 where the specification teaches the structure and operating capabilities of a *controller of a decoder*.

Building on all that precedes it, **example #5**, which begins on page 248, then relates how the integrated system processes a multichannel communications system, which conveys different types of signals, in order to monitor programming availability and enable receiver station apparatus to receive desired programming.

From pages 278 through 312, in **example #6** and especially **example #7**, which includes both digital and analog television signals and relates to the "Wall Street Week" program (and which has further disclosure at pages 427 through 447), the specification teaches regulating reception and use of programming of the integrated system of programming communication.

At page 312 *et seq.* it relates further monitoring concepts.

From page 324 through page 390 the specification teaches a series of transmitter station and transmitter network concepts. This portion of the specification also relies on all previous disclosure in that special attention is given to intermediate transmission stations which, *as receiver stations*, respond to programming transmissions of the integrated system as well as storing, organizing, generating, and transmitting programming. At page 340 *et seq.* **example #8** teaches distribution to, storage and organization at, and retransmission from intermediate transmission stations ("ITS") of SPAM programming -- most specifically television spot commercials. At page 354 *et seq.* **example #9** teaches automating intermediate transmission station combined medium operations by describing how an intermediate transmission station responds to an intermediate generation set and other elements of the integrated system to generate processor code and data and transmit the code and data with SPAM programming -- spot commercial unit Q of example #8 -- all of which are subsequently shown in the specification to operate at receiver stations to deliver receiver specific programming at video monitors, speakers, printers, and transmitters (telephones which communicate to remote data collection stations). At page 374 *et seq.* **example #10** extends the transmitter and network automating concepts of examples #8 and #9 by disclosing *a plurality of* intermediate transmission stations generating processor code and data, in the fashion of example #9, and inserting different code and data into a *network originated* transmission of SPAM programming -- again the unit Q television spot commercial.

From page 390 through 516, the specification discloses further ultimate receiver station ("URS") automation concepts, including regulating the URS environment (page 396 *et seq.*), controlling multiple receivers and output devices to present coordinated output (page 406 *et seq.*), receiving selected programming of the integrated system (page 419 *et seq.*), certain *integrated system computer system concepts* (page 427 *et seq.*), whose **example #7** (page 427 *et seq.*) description relies on the receiving selected programming concepts of pages 419-427. At page 447 *et seq.* the specification discloses certain data maintenance, timing control, efficiency, and other concepts involved in controlling combined media operations. At page 457 *et seq.* the specification discloses certain timing, imaging, communication, and transmission processing concepts that relate to efficient delivery of integrated system programming. At page 463 *et seq.* the specification relates to user specific audio, print, and other combined media besides receiver specific video. With all this preparation, the specification is finally able to teach, from page 469 through page 516, the combined media presentation of **examples #9 and #10** at a plurality of ultimate receiver station (which are responding to signals sent by different intermediate transmission stations). At page 516 *et seq.* the specification discloses enhancing and extending functionality of the integrated system by reprogramming receiver apparatus and enabling receiver stations to process transmissions having new forms of composition.

Finally, at page 533 *et seq.* the specification discloses "**Summary Example**" (#11) which teaches a very large scale integrated data processing and communications problem and its solution(s), using *all of* the disclosed integrated system with iterative broadcasting, response, and refinement.

Because of the integrated nature of the disclosure, no part of the specification is intended to be considered *in isolation*. However, with regard to the present application, the invention is disclosed, among other places, in examples 9, 10 and 11 and in the '87

specification on pages 469 -516. The foregoing is intended to be exemplary only and in no way to limit the claimed invention to the cited passages.

**C. Determination of effective filing date**

With respect to the examiner's assertion, in **paragraph 2**, that no attempt to will be made to determine the effective filing date of this application, applicant claims priority under 35 U.S.C. § 120 of the following applications:

<u>Serial No.</u>	<u>Filing Date</u>	<u>Patent No.</u>
08/113,329	August 30, 1993	Pending
08/056,501	May 3, 1993	5,335,277
07/849,226	March 10, 1992	5,233,654
07/588,126	September 25, 1990	5,109,414
07/096,096	September 11, 1987	4,965,825

Consequently, the Applicants will demonstrate disclosure only with respect to the application filed Sept. 11, 1987, having serial no. 07/096,096, issued as patent no. 4,965,825 (the '87 case).

**D. Duty to maintain line of patentable demarcation between related patents**

As to the paragraph numbered 3, applicants acknowledge their duty to maintain a line of patentable demarcation between related applications. Assuming, arguendo, that substantially duplicate claims exist, the applicants intend to make a good faith

effort to alert the PTO of any instances in which the PTO treats such claims inconsistently.

**E. Use of alternative claim language**

**As to the paragraph numbered 4, applicants acknowledge and appreciate the examiner's concern over the use of alternative claim language. Applicants assert that they believe that the disclosure supports every possible embodiment or permutation that can be created using said language. During the prosecution of this application, applicants intend to ensure that the disclosure supports each possible embodiment claimed using alternative claims.**

**F. Determination of possible non-statutory obvious-type double patenting rejections in related 327 applications**

**In paragraph 10 of the office action, the Examiner states that "determination of a possible non-statutory double patenting rejection obvious-type in each of the related 327 applications over each other will be deferred until a later time." Applicants submit that the examiner and the PTO cannot defer further rejections to a later time. Every ground of rejection should be made in examiner's first Office Action. 37 CFR § 1.104(a) states that "[o]n taking up an application for examination . . . the examiner shall make a**

thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect to both compliance of the application . . . with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.” The MPEP states “[t]he examiner’s action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before action is made.” MPEP § 707.07, citing 37 CFR § 1.105. Finally, “[p]iecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available . . . .” “Where a major technical rejection is proper, it should be stated with full development of reasons rather than by mere conclusion coupled with some stereotyped expression.” MPEP § 707.07(g). Applicants submit that the examiner has a duty to give each application a complete examination, to make rejections with specificity, and that not to defer rejections.

#### **G. Acknowledgment of Multiplicity rejection**

With regard to paragraph 12 of the office action discussing that a multiplicity rejection was mailed in the parent file app. ser. no. 07/096,096, Applicant’s submit that the PTO gave a multiplicity rejection in that case and limited Applicants to 25 claims. Roughly one hundred claims had been originally filed. There was no substantive review of any of the other claims outside the twenty five. Applicants were not

permitted to submit additional claims although a request was made. The Applicant's disclosure addresses too many subject areas to be adequately covered by a small number of claims. Applicants submit that the "nexis" [sic] analysis is not required by Applicants.

#### **H. Acknowledgment of Interviews**

**As to the grouping of paragraphs numbered 17,** applicants acknowledge and appreciate the interviews provided by the PTO. Applicants also appreciate the detailed description of the interviews provided in the Office Action. The Office Action states that "the Group would like to have a complete grouping of applications in a manner that was submitted earlier for only a portion of the total filings." Applicants note that based on the Office Actions received thus far, the PTO does not appear to be following the groupings applicants submitted previously. The order of examination of applicants' applications do not seem to have any correspondence to the groupings previously submitted. Applicants, therefore, will not supply further groupings. Applicants will, however, gladly supply further groupings if requested by the PTO for the purpose of following these groupings. Mr. Groody has confirmed in a telephone conversation between Mr. Groody and Mr. Scott that no more groupings need be sent.

In the interest of maintaining a clear record, applicants respectfully traverse the Office Action's interview summary statement that an offer was made to terminally disclaim the present application with the '81 or '87 patents. Rather, applicants respectfully submit that their offer was to disclaim a block of copending applications against one another, provided their issue date was in close enough proximity so as not to result in unnecessarily great losses in patent term duration.

## **I. Rejections based on 35 U.S.C. §112**

### **1. Rejections based on Formalities**

On the 17th line of amended claim 10, the “a” just prior to “remote site” has been replaced with “said” in view of the antecedent basis established earlier in the 16th line of the claim.

### **2. Rejections based on Metes and Bounds**

Claims 10 - 12 were also rejected under 35 U.S.C. §112, second paragraph, as indefinite because the examiner was unable to “determine the meets [sic]and bounds of the claims to perform an effective search and analysis over the prior art.” Applicant’s respectfully submit that this rejection is traversed by the amendment which clarifies the claims in response to the examiner’s specific objections and rejections. The Office Action states that the “examiner is not certain that the meets [sic] and bounds of these claims can be determined because of the language in the disclosure and claims.” It further states that “[a]pplicants are being requested to reference the claim limitations in this application to the disclosure so that the meets [sic] and bounds of these claims can be properly considered.” Applicants traverse this rejection and submit they are under no duty to prospectively reference claim limitations to the specification where the examiner has not specifically identified what is objected to as indefinite. The M.P.E.P.

§2111 states that “[d]uring patent examination, the pending claims must be ‘given the broadest reasonable interpretation consistent with the specification.’” Also, it is only “when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language.” M.P.E.P. §2111.01. Applicants respectfully request that this blanket rejection for indefiniteness be withdrawn.

Applicant’s amendments to claims 10 - 12 are believed to have eliminated any indefiniteness issues and therefore, applicants respectfully request reconsideration of the rejections of claims 10 - 12 under 35 U.S.C. 112, second paragraph for being indefinite.

#### **J. Rejections under 35 U.S.C. §102(e)**

*Claims 10 - 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Saeki et al. (4,455,570).*

##### **1. Rejections of Record**

**Claim 10** is not anticipated by the Saeki patent. Claim 10 is directed to the steps of: A) outputting combined medium programming, said interactive mass medium program output apparatus having an input device to receive input from a subscriber; B) prompting said subscriber during said combined medium programming outputting whether said subscriber wants said specific combined medium programming, said interactive mass medium program output apparatus having a memory for storing one

of a code and a datum; C) receiving a reply from said subscriber at said input device in response to said prompting said subscriber, said interactive mass medium program output apparatus having a processor for processing said subscriber reply; D) processing said and selecting one of said a code and said datum designating said specific combined medium programming, said interactive mass medium program output apparatus having a transmitter for communicating with a remote site; E) communicating one of said selected code and said selected datum to said remote site, said interactive mass medium output apparatus and said remote site forming part of a network having a plurality of transmitter stations; F) assembling, in said network, at least one message which is effective at said interactive mass medium program output apparatus to satisfy said reply, said interactive mass medium program output apparatus having a receiver for receiving a signal containing at least a portion of said at least one message from said remote station; and G) delivering said designated specific combined medium programming on the basis of said at least one message.

Saeki fails to disclose or show the step D, *selecting one of said code and said datum designating said specific combined medium programming* and step E, *communicating one of said selected code and said selected datum to said remote*. The examiner states the Saeki reference discloses a system whereby the address circuit (39-6) of the logic controller (39) has a memory for storing a code. The applicant has not found any such description in the specification of Saeki. The video data processing section (35) of the converter (10) has a video data memory (42) used for temporary storage, and the central facility has a data memory storage section (32), however this is not the same as the address detector (39-6) as recited by the examiner. With that in mind, the Saeki reference does not disclose step D and step E, as stated above. In Saeki, the television selection is made by the subscriber at the control box (12), the signal is then sent to the central facility. The central facility sends a television signal to the converter (10) at the subscriber's station.

This differs from the claimed invention because in the present invention, the interactive output apparatus processes the reply and selects a code or datum designating specific combined medium programming and then communicates such code or datum to a remote site. In the Saeki patent, the examiner has identified the converter (10) as the mass medium program output apparatus. The converter in Saeki does not select a code or datum designating the specific combined medium programming, the computer which is in the central facility (identified as the remote site by the examiner) calls the data processing section which then reads video data from a video list out of the data memory section. The read video data is then subjected to modulation in the data modulation transmission section and then transmitted to the converter. (Saeki, col. 6, lines 28 - 39). Nowhere in the Saeki reference is it disclosed that the mass medium program output apparatus selects code or datum designating the specific combined medium programming. Therefore, the converter cannot communicate such code or datum with a remote site, because no such code or datum was selected at the converter.

Saeki does not disclose step F, *assembling a message which is effective at said interactive mass medium program output apparatus to satisfy said reply, said interactive mass medium program output apparatus having a receiver for receiving a signal containing at least a portion of said at least one message from said remote station.* Saeki does not assemble any message. In Saeki, video data is read from a video data list out of the data memory section. Such video data is then transmitted to the converter box. This does not equate to assembling a message.

Saeki does not disclose step G, *delivering said designated specific combined medium programming on the basis of said at least one message..* The examiner contends that the remote site transmits over the CATV network, messages corresponding to the selected combined medium programming to a receiver at the output apparatus. (Saeki, col. 6,

lines 28 - 39). This is a misinterpretation of the Saeki reference. What Saeki shows is the central facility receives a command signal, the computer detects the command signal and calls the data processing section. The data processing section reads video data from a video data list out of the data memory section and then sends such video data to the converter. This differs from the claimed invention. According to the examiner, the central facility is actually the remote site. That being the case, then all of the processing is occurring at the remote site and being transmitted to the subscriber's television instead of occurring at the mass medium output apparatus. Also, there is no mention in Saeki of a message being assembled, as stated above, and therefore the designated specific combined medium programming cannot be delivered on the basis of a message that doesn't exist. Therefore it is respectfully requested the rejection be withdrawn.

In claim 11, the present application claims the steps of A) receiving a combined medium programming transmission at a transmission station; B) generating said specific combined medium program; and C) transmitting said specific combined medium program, said combined medium program enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said specific combined medium programming, receive and process a reply from said subscriber, communicate one of selected code and selected datum designating said specific combined medium programming, and receive at least one message from a remote station, said at least one message effective to satisfy said reply from said subscriber.

Saeki fails to disclose step B, *generating said specific combined medium program.*

The Saeki reference does not disclose a transmission station generating a specific combined medium program. In Saeki, the examiner has cited the central facility as the transmission station, yet he also identified it as the remote site thus confusing the applicant how it can be two separate locations at the same time. Regardless, assuming the central facility is the transmission station, it still does not generate a combined medium program. The computer in the central facility merely calls the data processor which reads video data from a list and then transmits such data to the converter. This is not equivalent to generating specific combined medium programming. The examiner states the combined medium program is generated via a source group. According to the specification, a signal is received at the antenna (13) which is connected to the demodulator in the source group (14). The signals are then applied to a modulation and transmission section (19). The signal is then sent to transmitter/receiver (25) which then communicates with the converter (10). (Saeki, col. 1, lines 35 - 52). Nothing is generated, preexisting programs are merely transmitted.

Saeki fails to show or disclose step C, *transmitting said specific combined medium program, said combined medium program enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said combined medium programming, receive and process a reply from said subscriber, communicate one of selected code and selected datum designating said specific combined medium programming and receive at least one message from a remote station, said at least one message effective to satisfy said reply from said subscriber.* Saeki does not disclose a system where at least one message effective to

satisfy the reply from the subscriber is received from a remote station. In Saeki, the video data televised to the subscriber in response to their input comes from within the available data stored in the video data memory section. (Saeki, col. 7, lines 51 - 55). Therefore it is respectfully requested the rejection be withdrawn.

**In claim 12,** the present application claims the steps of A) receiving a combined medium programming transmission to be transmitted; B) receiving an instruct signal which is effective to either effect a transmission station or a receiver station to generate said specific combined medium program, said combined medium program enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said specific combined medium programming, receive and process a reply from said subscriber, communicate one of selected code and selected datum designating said specific combined medium programming, and receive at least one message from a remote station, said at least one message effective to satisfy said reply from said subscriber; C) receiving a transmitter control signal which operates at said transmitter station to communicate said specific combined medium program to a transmitter; and D) transmitting said specific combined medium programming transmission, said instruct signal and said transmitter control signal.

The Saeki reference does not disclose or show step B, *an instruct signal that is effective to accomplish effecting a transmission station or a receiver station to generate a combined mass medium program which enables the mass medium program output apparatus to prompt a subscriber for input with respect to specific combined medium programming, receive a reply and process a reply from the subscriber, communicate a code or datum designating the specific combined medium programming and receive at least one message from a remote station that satisfies the reply from the subscriber*, or step D, *transmitting the specific combined medium programming transmission, said instruct signal and the transmitter control signal*.

The examiner states such instruct signal is inherent in Saeki. The applicant's disagree. It is not inherent in the Saeki reference that an instruct signal is received that would effect either a transmission station or a receiver station because Saeki does not disclose a transmission station or a receiver station generating a combined mass medium program, which enables the mass medium program output apparatus to prompt a subscriber for input, receiving and processing the subscriber's reply, communicating selected code or datum designating specific combined medium programming and receiving at least one message from a remote station that satisfies the reply, for the reasons set forth above. At the very least, in Saeki the converter performs certain, but not all of the above listed functions and the central facility performs certain but not all of the above listed functions. There is definitely not two separate locations, that of the receiver station and the other of the transmitter station, that both perform all of the functions. Therefore, there is not inherent that an instruct signal is received in the Saeki system as stated in the claimed invention. With no instruct signal shown in the Saeki reference, it cannot later be transmitted (as in step D) along with the specific combined medium programming transmission and the transmitter control signal as claimed, thus failing to disclose the necessary steps to anticipate the claimed invention. Therefore it is respectfully requested the rejection be withdrawn.

## 2. Summary

Applicant's respectfully submit that each of the pending claims clearly contain elements or an element which is absent in the cited reference, therefore precluding a rejection under 35 U.S.C. § 102. Applicants further submit that the subject matter of each claim would not have been obvious to one of ordinary skill in the art at the time

the invention was made. Applicants respectfully request that the rejections of the pending claims be withdrawn and all claims be permitted to issue.

**K. Rejections based on the judicially created doctrine of non-statutory, non-obvious type double patenting**

The examiner's rejection of claims 10 - 12 under the judicially created doctrine of non-statutory, non-obvious type double patenting over the patented claims in U.S. patents 4,694,490; 4,704,725; 4,965,825 and 5,109,414 is hereby traversed.

In this application, the PTO fails to specifically identify all claims from cited Harvey patents that cover specific claims in the present application. Rather, the Office Action references "representative claims" from patents and the present application. The Office Action does not cite specific elements from claims in a patent covering specific elements in claims in the application. In fact, the Office Action acknowledges that the patent claims and application claims are directed to different elements, but states that this "does not prohibit this rejection if there is common or interrelated subject matter recited." The Office Action then references Schneller in support of this erroneous statement, not supported by Schneller.

The claims in the present application are distinct from the claims in the Harvey patents. As previously mentioned, the Office Action states that the independent and distinct standard was the main factor in the Schneller court's determination that the double patenting rejection should be affirmed. The Office Action has misinterpreted this phrase. This phrase means independent 'or' distinct. MPEP (6th ed.) § 802.01. The

MPEP defines independent as meaning "that there is no disclosed relationship between the two or more subjects disclosed" and that they are not connected. The MPEP defines the term distinct as meaning that "two or more subjects disclosed are related . . . but are capable of separate manufacture, use, or sale as claimed . . ." Two or more subjects cannot then be unrelated, independent, and also related, and thus distinct. Analyzing the PTO's cited representative claims referenced in the Office Action, the claims of the present application are clearly distinct from the claims in the patents and therefore the claims in the present application are patentable. Although not required, applicants will analyze the claims of the present application with respect to the designated representative claims of Harvey U.S. Patents 4,694,490 and 4,704,725.

**1. Representative claim 7 of the U.S. patent 4,694,490 as applied to the present application claim 12**

Patent 4,694,490, claim 7 claims a method of communicating television program material, said material including a video signal containing a television program and an instruct-to-overlay signal, to multiple receiver stations. The video signal is received and the instruct-to-overlay signal detected and processed by a computer. The computer generates and transmits its overlay video signals to a television receiver which presents a combined display of the television program and overlay video signals, said display being specific to a particular user.

Present application claim 12, as amended, relates to a method for specific combined medium programming delivery for use with an interactive mass medium

program output apparatus, comprising the steps of: receiving a combined medium programming transmission to be transmitted; receiving an instruct signal which is effective to accomplish either effecting a transmission station or a receiver station to generate said specific combined medium program, said combined medium program enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said combined medium programming, receive and process a reply from said subscriber, communicate selected code or datum designating said specific combined medium programming, and receive at least one message from a remote station, the message effective to satisfy said reply from said subscriber; receiving a transmitter control signal which operates at said transmitter station to communicate said specific combined medium program to a transmitter; and transmitting said specific combined medium programming transmission, said instruct signal and said transmitter control signal.

Patent claim 7 does not cover present application claim 12. Patent claim 7 relates to instruct-to-overlay signals that are processed by a computer and received by a television receiver which presents a combined display of the instruct-to-overlay signal and a television program. This application claim 12 relates to receiving a combined medium programming transmission, receiving an instruct signal that either effects a transmission station or a receiver station to generate said specific combined medium program, said combined medium programming enabling the interactive mass medium program output apparatus to prompt a subscriber for input, receiving a transmitter control signal that operates to communicate the specific combined medium program to

a transmitter and transmitting the specific combined medium programming transmission, the instruct signal and the transmitter control signal. The two claims are capable of separate manufacture, use, and sale as claimed and, as such, these two inventions are distinct.

**U.S. patent 4,694,490, claim 7**

In a method of communicating television program material to a multiplicity of receiver stations each of which includes a television receiver and computer, the computers being adapted to generate and transmit overlay video signals, to their associated television receivers, said overlay signals causing the display of user specific information related to said program material, and with at least some of said computers being programmed to process overlay modification control signals so as to modify the overlay video signals transmitted to their associated receivers, each of said computers being programmed to accommodate a specific user application, and wherein a video signal containing a television program signal and an instruct to-overlay signal are transmitted to said receiver stations, the steps of:  
receiving said video signal at a plurality of receiver stations and displaying said program material on the video receivers of selected ones of said plurality of receiver stations  
detecting the presence of said instruct-to-overlay signal at said selected receiver stations at a time when the corresponding overlay is not being displayed, and

**Present application, claim 12 (amended)**

A method for specific combined medium programming delivery for use with an interactive mass medium program output apparatus, comprising the steps of:  
receiving a combined medium programming transmission to be transmitted;  
receiving an instruct signal which is effective to accomplish one of:  
(a) effecting a transmission station to generate said specific combined medium program, said combined medium program enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said combined medium programming, receive and process a reply from said subscriber, communicate one of selected code and selected datum designating said specific combined medium programming, and receive at least one message from a remote station, said at least one message effective to satisfy said reply from said subscriber; and  
(b) effecting a receiver station to generate said specific combined medium program, said combined medium program enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said combined medium programming, receive

coupling said instruct-to-overlay signal to the computers at said selected receiver stations, and causing the computers at said selected receiver stations to generate and transmit their overlay video signals to their associated television receivers in response to said instruct-to-overlay signal, thereby to present a combined display at the selected receiver stations consisting of the television program and the related computer generated overlay, the overlays displayed at a multiplicity of said receiver stations being different, with each display specific to a specific user.

and process a reply from said subscriber, communicate one of selected code and selected datum designating said specific combined medium programming, and receive at least one message from a remote station, said at least one message effective to satisfy said reply from said subscriber; receiving a transmitter control signal which operates at said transmitter station to communicate said specific combined medium program to a transmitter; and transmitting said specific combined medium programming transmission, said instruct signal and said transmitter control signal.

**2. Representative claim 3 of the U.S. patent 4,704,725 as applied to the present application claim 12**

Patent 4,704,725, claim 3 claims a method of communicating output signals comprising data and user specific signals at a multiplicity of receiver stations from computers to output devices. At least some of the computers can modify the user specific signals by processing modification control signals. The computers communicate the data and user specific signals in response to a received and detected instruct-to-transmit signal.

Present application claim 12, as amended, relates to a method of for specific combined medium programming delivery for use with an interactive mass medium program output apparatus, comprising the steps of: receiving a combined medium programming transmission to be transmitted; receiving an instruct signal which is

effective to accomplish either effecting a transmission station or a receiver station to generate said specific combined medium program, said combined medium program enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said combined medium programming, receive and process a reply from said subscriber, communicate selected code or datum designating said specific combined medium programming, and receive at least one message from a remote station, the message effective to satisfy said reply from said subscriber; receiving a transmitter control signal which operates at said transmitter station to communicate said specific combined medium program to a transmitter; and transmitting said specific combined medium programming transmission, said instruct signal and said transmitter control signal.

Patent claim 3 does not cover present application claim 12. Patent claim 3 relates to the communication of user specific signals. This application claim 12 relates to receiving a combined medium programming transmission, receiving an instruct signal that either effects a transmission station or a receiver station to generate said specific combined medium program, the combined medium programming enabling the interactive mass medium program output apparatus to prompt a subscriber for input, receiving a transmitter control signal that operates to communicate the specific combined medium program to a transmitter and transmitting the specific combined medium programming transmission, the instruct signal and the transmitter control signal. The two claims are capable of separate manufacture, use, and sale as claimed and, as such, these two inventions are distinct.

**U.S. patent 4,704,725, claim 3**

A method of communicating data to a multiplicity of receiver stations each of which includes a computer adapted to generate and transmit user specific signals to one or more associated output devices, with at least some of said computers being programmed to process modification control signals so as to modify the user specific signals transmitted to their associated output devices, each of said computers being programmed to accommodate a special user application, comprising the steps of: transmitting an instruct-to-transmit signal to said computers at a time when the corresponding user specific information is not being transmitted to an output device; detecting the presence of said instruct-to-transmit signal at selected receiver stations and coupling said instruct-to-transmit signal to the computers associated with said selected stations, and causing said last named computers to generate and transmit their user specific signals to their associated output devices in response to said instruct-to-transmit signal, thereby to transmit to the selected output devices an output signal comprising said data and said related user specific signals, the output signals at a multiplicity of said output devices being different, with each output signal specific to a specific user.

**Present application, claim 12 (amended)**

A method for specific combined medium programming delivery for use with an interactive mass medium program output apparatus, comprising the steps of:

receiving a combined medium programming transmission to be transmitted;

receiving an instruct signal which is effective to accomplish one of:

(a) effecting a transmission station to generate said specific combined medium program, said combined medium program enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said combined medium programming, receive and process a reply from said subscriber, communicate one of selected code and selected datum designating said specific combined medium programming, and receive at least one message from a remote station, said at least one message effective to satisfy said reply from said subscriber; and

(b) effecting a receiver station to generate a specific combined medium program, said combined medium program enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said combined medium programming, receive and process a reply from said subscriber, communicate one of selected code and selected datum designating said specific combined medium programming, and receive at least one message from a remote station, said at least one message effective to satisfy said reply from said subscriber;

receiving a transmitter control signal which operates at said transmitter station to communicate said specific combined medium program to a transmitter; and

transmitting said specific combined medium programming transmission, said instruct signal and said transmitter control signal.

**3. Representative claim 24 of the U.S. patent 4,965,825 as applied to the present application claim 12**

Patent 4,965,825, claim 24 claims a method of generating user specific output information at a multiplicity of receiver stations. Each receiver station is programmed with a special user application and has a computer adapted to generate user specific output information. Each receiver station has an output device to which its computer transmits a user specific signal. At a time when the user specific output information does not exist, an instruct-to-generate signal is transmitted to the receiver stations. In response to the instruct-to-generate signal, the computers generate and transmit to the output devices the user specific output information in user specific signals which are different, "with each output signal specific to a specific user".

Present application claim 12, as amended, relates to a method for specific combined medium programming delivery for use with an interactive mass medium program output apparatus, comprising the steps of: receiving a combined medium programming transmission to be transmitted; receiving an instruct signal which is

effective to accomplish either effecting a transmission station or a receiver station to generate said specific combined medium program, said combined medium program enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said combined medium programming, receive and process a reply from said subscriber, communicate selected code or datum designating said specific combined medium programming, and receive at least one message from a remote station, the message effective to satisfy said reply from said subscriber; receiving a transmitter control signal which operates at said transmitter station to communicate said specific combined medium program to a transmitter; and transmitting said specific combined medium programming transmission, said instruct signal and said transmitter control signal.

Patent claim 24 does not cover present application claim 12. Claim 24 relates to user specific signals sent from the receiver station to an output device. This application claim 12 relates to receiving a combined medium programming transmission, receiving an instruct signal that either effects a transmission station or a receiver station to generate said specific combined medium program, the combined medium programming enabling a the interactive mass medium program output apparatus to prompt a subscriber for input, receiving a transmitter control signal that operates to communicate the specific combined medium program to a transmitter and transmitting the specific combined medium programming transmission, the instruct signal and the

transmitter control signal. The two claims are capable of separate manufacture, use, and sale as claimed and, as such, these two inventions are distinct.

U.S. patent 4,965,825, claim 24	Present application, claim 12 (amended)
<p>In a method of generating computer output at a multiplicity of receiver stations each of which includes a computer adapted to generate and transmit user specific output information content and user specific signals to one or more associated output devices, with at least one or more associated output devices, with at least some of said computers being programmed to process modification control signals so as to modify said computers' method of processing data and generating output information content, each of said computers, being programmed to accommodate a special user application, the steps of: transmitting an instruct-to-generate signal to said computers at a time when corresponding user specific output information content does not exist, and causing said last named computers to generate their user specific output information content in response to said instruct-to-generate signal, thereby to transmit to each of their associated output devices an output information content and the user specific signal of its associated computer, the output signals at a multiplicity of said output devices being different, with each output signal specific to a specific user.</p>	<p>A method for specific combined medium programming delivery for use with an interactive mass medium program output apparatus, comprising the steps of: receiving a combined medium programming transmission to be transmitted; receiving an instruct signal which is effective to accomplish one of: (a) effecting a transmission station to generate said specific combined medium program, said combined medium program enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said combined medium programming, receive and process a reply from said subscriber, communicate one of selected code and selected datum designating said specific combined medium programming, and receive at least one message from a remote station, said at least one message effective to satisfy said reply from said subscriber; and (b) effecting a receiver station to generate said specific combined medium program, said combined medium program enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said combined medium programming, receive and process a reply from said subscriber, communicate one of selected code and selected datum designating said specific</p>

combined medium programming, and receive at least one message from a remote station, said at least one message effective to satisfy said reply from said subscriber; receiving a transmitter control signal which operates at said transmitter station to communicate said specific combined medium program to a transmitter; and transmitting said specific combined medium programming transmission, said instruct signal and said transmitter control signal.

**4. Representative claim 15 of the U.S. patent 5,109,414 as applied to the present application claim 12.**

Patent 5,109,414, claim 15 claims a signal processing system which receives data from a data source and outputs the data to a matrix switch and a detector, control signals are detected within the received data and stored for further processing, and a processor controls the directing functions of (1) the matrix switch which receives the data as input and can direct selected portions of the data to a data transmission means and (2) the device which stores and transfers the control signals to the processor.

Present application claim 12, as amended, relates to a method for specific combined medium programming delivery for use with an interactive mass medium program output apparatus, comprising the steps of: receiving a combined medium programming transmission to be transmitted; receiving an instruct signal which is effective to accomplish either effecting a transmission station or a receiver station to generate said specific combined medium program, said combined medium program

enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said combined medium programming, receive and process a reply from said subscriber, communicate selected code or datum designating said specific combined medium programming, and receive at least one message from a remote station, the message effective to satisfy said reply from said subscriber; receiving a transmitter control signal which operates at said transmitter station to communicate said specific combined medium program to a transmitter; and transmitting said specific combined medium programming transmission, said instruct signal and said transmitter control signal.

Patent claim 15 does not cover present application claim 12. Patent claim 15 relates to a data system that receives and processes data from a data source and includes a processor that controls the functions of a matrix switch and a storage device. This application claim 12 relates to receiving a combined medium programming transmission, receiving an instruct signal that either effects a transmission station or a receiver station to generate said specific combined medium program, said combined medium programming enabling the interactive mass medium program output apparatus to prompt a subscriber for input, receiving a transmitter control signal that operates to communicate the specific combined medium program to a transmitter and transmitting the specific combined medium programming transmission, the instruct signal and the transmitter control signal. The two claims are capable of separate manufacture, use, and sale as claimed and, as such, these two inventions are distinct.

**U.S. patent 5,109,414, claim 15**

In a signal processing system,  
a receiver/distribution means for receiving data from a data source and for outputting said data to a matrix switch means and a control signal detector means,  
a matrix switch means for receiving said data from said receiver/distributor means and for directing selected portions of said received data to a data transmission means,  
a control signal detector means for detecting control signals respecting said data and transferring said control signals to a storage/transfer means, said control signal means being configured to detect said control signals at a predetermined location within said data,  
a storage/transfer means for receiving and storing said control signals and for transferring at least a portion of said control signals to a processor means for further processing, and  
a processor means for controlling the directing functions of said matrix switch means and the transfer functions of said storage/transfer means based on instructions contained in said control signals.

**Present application, claim 12 (Amended)**

A method for specific combined medium programming delivery for use with an interactive mass medium program output apparatus, comprising the steps of:  
receiving a combined medium programming transmission to be transmitted;  
receiving an instruct signal which is effective to accomplish one of:  
(a) effecting a transmission station to generate said specific combined medium program, said combined medium program enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said combined medium programming, receive and process a reply from said subscriber, communicate one of selected code and selected datum designating said specific combined medium programming, and receive at least one message from a remote station, said at least one message effective to satisfy said reply from said subscriber; and  
(b) effecting a receiver station to generate said specific combined medium program, said combined medium program enabling said interactive mass medium program output apparatus to prompt a subscriber for input in respect of said combined medium programming, receive and process a reply from said subscriber, communicate one of selected code and selected datum designating said specific combined medium programming, and receive at least one message from a remote station, said at least one message effective to satisfy said reply from said subscriber;  
receiving a transmitter control signal which operates at said transmitter station to communicate said specific combined medium program to a

transmitter; and  
transmitting said specific combined  
medium programming transmission, said  
instruct signal and said transmitter control  
signal.

Claims 12 - 12 are rejected under the judicially created doctrine of double patenting over the claims of copending U.S. application 08/113,329 and other listed U.S. applications. Applicants submit that this rejection, even if appropriately made with specificity, should be a provisional double patenting rejection until one or more of the copending applications issues, at which time the rejection can be made non-provisional. Applicants respectfully request that this rejection be withdrawn.

Also, although the rejection is stated as a judicially created obviousness double patenting rejection, the examiner's arguments are those of a Schneller non-obviousness, non-statutory double patenting rejection. Applicant's reply brief addresses the merits of the Schneller-type rejection.

Applicants traverse the assertion that a double patenting situation exists.

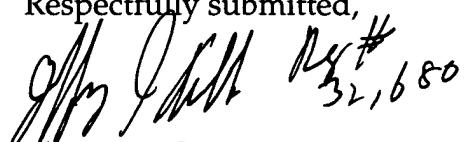
### III. CONCLUSION

In accordance with the foregoing it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, that all pending claims patentably distinguish over the prior art, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the

application is submitted as being in a condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for telephone interview to discuss resolution of such informalities.

Respectfully submitted,



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